

#8

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED  
UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)

First named inventor: Jifan Hu, M.D., Ph.D.

Application No.: US 09/643,128

Art Unit:

Filed:

Examiner:

Title: Gene Inactivation by Targeted DNA Methylation

Attention: Office of Petitions  
Assistant Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

NOTE: If information or assistance is needed in completing this form, please contact Petitions  
Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper reply to a  
notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the  
expiration date of the period set for reply in the Office notice or action plus an extensions of time  
actually obtained.

**APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION**

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee --required for all utility and plant applications  
filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

**1. Petition fee**

☒ Small-entirety-fee \$ 640 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity - fee \$ \_\_\_\_\_ (37 CFR 1.17(m))

**2. Reply and/or fee**

A. The reply and/or fee to the above-noted Office action in

the form of \_\_\_\_\_ (identify type of reply):

- ☐ has been filed previously on \_\_\_\_\_  
☐ is enclosed herewith.

B. The issue fee of \$ \_\_\_\_\_

- ☐ has been paid previously on \_\_\_\_\_  
☐ is enclosed herewith.

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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## 3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ \_\_\_\_\_ for a small entity or \$ \_\_\_\_\_ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE. The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D))].

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

9-17-2002  
Date

Telephone  
Number: (650) 493-5000  
X63175

[Signature]  
Signature

JIFAN HU

Typed or printed name

525 DEL REY Ave., Suite B  
Address

Sunnyvale, CA 94085

Enclosures: ☒ Fee Payment

☒ Reply

☐ Terminal Disclaimer Form

☒ Additional sheets containing statements establishing unintentional delay

☐ Other: Self-posted card, Disk for seq. listing

## CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☐ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Box DAC, Washington, D.C. 20231.

☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 308-6916.

\_\_\_\_\_  
Date

\_\_\_\_\_  
Signature

\_\_\_\_\_  
Type or printed name of person signing certificate



# **GMR Epigenetics**

525 Del Rey Ave., Suite B  
Sunnyvale, CA 94085, USA  
Phone: (650) 248-3617  
Fax: (408) 523-6261

To: Office of Petitions  
Assistant Commissioner for Patents  
2201 South Clark Place  
Bldg 3C23  
Arlington, Virginia 22202  
Tel: 703-305-9282

From: Jifan Hu, M.D., Ph.D.  
President  
GMR Epigenetics

c/o: Petition for reviving the abandoned patent application (No: 09/643,128)

Sept. 12, 2002

Dear Commissioner,

As one of the inventors of the US Patent Application (No: 09/643,128), I am writing to appeal to revive the patent application. Here is the whole story for the application process.

The patent was originally prepared and filed by patent attorney Rahul Pathak at Pennie & Edmonds (Palo Alto, CA) on behave of our company. They filed the application on Dec. 15, 2000 with the reference number of 10583-0005-999. However, after filing, Pennie & Edmonds had their internal agreement that they will not work on any cases in which Stanford University was the assignee. Because GMR Epigenetics and Stanford University were the jointed assignees for the application, Pennie & Edmonds decided to discontinue the case for us. Because we lacked funds to have a new patent attorney to take care of the case, we simply asked them to retrun all documents to Dr. Neil Dey at GMR Epigenetics.

However, for some reasons, Pennie & Edmonds had not appropriately transferred the Power of Attorney to us as we assumed it had been. As a result of this miscommunication, we have not received any response and requests from USPTO office. Meanwhile, Pennie & Edmonds did not transfer us any documents they received from your office. We just patiently wait and wait until this morning I began to learn that our patent was abandoned just last month. In addition, we have moved from our original Mountain View office to Sunnyvale after filing the patent. It may account for the failure in receiving the mails and response.

Considering this special case, we would appreciate your help with reviving the patent application.

1). Please change correspondence address and power of attorney from our original patent attorney Pennie & Edmonds to our company:

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Dr. Jifan Hu, President and inventor, GMR Epigenetics, 525 Del Rey Avenue, Suite B, Sunnyvale, CA 94085, Phone: (650) 493-5000, ext. 63175 or 63186, Fax: (408) 523-6261, E-mail: [jifan@gmrusa.com](mailto:jifan@gmrusa.com). I will personally handle the case until we find an appropriate attorney for the case in the future.

2). Please find the attached disk containing "Sequence List". "The information recorded in computer readable form is identical to the written sequence listing". However, some sequence ID errors in original version were corrected:

a). Seq ID aa =1, bb=2, cc=3, dd=4, zz=5, xx=6, and

b). Sequences in the table with missing ID numbers are renumbered as Seq ID #7-56 in order.

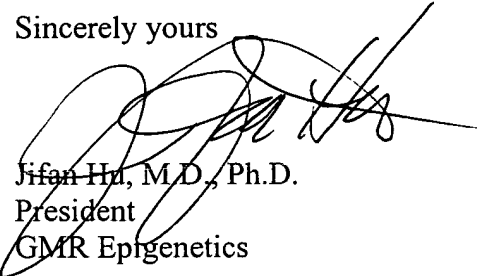
3). A petition form for reviving patent abandoned unintentionally under 37 CFR 1.137(b).

4). A check (\$640) for petition fee

5). A self-posted card for your returning messages

Please do not hesitate to contact me at 650-493-500, ext. 63175 or 63186 or e-mail me at [jifan@gmrusa.com](mailto:jifan@gmrusa.com) should you have questions for this petition.

Sincerely yours



Jifan Hu, M.D., Ph.D.  
President  
GMR Epigenetics